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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,022	03/25/2002	Toshihiro Morita	275729US6PCT	4603

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EXAMINER	
GARG, YOGESH C	

ART UNIT	PAPER NUMBER
3625	

NOTIFICATION DATE	DELIVERY MODE
08/07/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	09/889,022	MORITA ET AL.	
	Examiner	Art Unit	
	Yogesh C. Garg	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 July 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/20/2007 has been entered.

Response to Amendment

2. Applicant's amendment received on 7/20/2007 is acknowledged and entered. Claims 1,3,4,8,11,12,15,17,18,22,24, and 25 are currently amended. Claims 1-28 are pending for examination.

Response to Arguments

3.1. Applicant's arguments (see Remarks, filed on 7/20/2007) with respect to prior art rejection of claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 8, 15 and 22 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Epstein (US Patent 7,134,145 B1).

Regarding claim 1, Epstein discloses an information processing apparatus which checks out a content to an external device connected thereto or checks in a content from an external device connected thereto (See Fig.1), the apparatus comprising:

a title display means for displaying a title corresponding to the content (see at least Figs.1 and 2, col.3, lines 1-25 and col.4, lines 51-64. The catalog controller 110 of the Check-out / Check-in Device contains a list of each checked out and checked in content and tracks the number of copies checked-out to external devices or checked in

from external devices. Though not illustrated it would be obvious that the Check-out / Check-in Device would include a display means [such as a monitor/screen] to see the list/title of contents the number of copies available.) ;

a content checkout setting means for setting a plurality of contents prior to checking out the plurality of contents (Check-out / Check-in Device in Fig.1)

a number of checkouts display means for displaying a number of possible checkouts for the content, wherein the number of possible checkouts represents a number that is incremented by one when the content is checked back into the apparatus(see at least Figs. 1,2 and col.3, lines 1-27. The Checkout and Check-in device contains the means for displaying a number of possible checkouts for the content. When a copy of content is returned, that is checked back into the Device, the count of possible available checkouts is accordingly changed that is the Device indicates that one additional copy is now available for checkout).

> *When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § § 2112- 2112.02.*
>
> *Or*
>
> *When the reference teaches all claim limitations except a means plus function limitation and the examiner is not certain whether the element disclosed in the reference is an equivalent to the claimed element and therefore anticipatory, or whether the prior art element is an obvious variant of the claimed element. See MPEP § § 2183- 2184.*

In the above case, Epstein discloses all the limitations of claim 1 except for not explicitly disclosing the step of displaying and that would be obvious, as analyzed above.

Regarding claims 8, 15 and 22, their limitations are similar and are therefore analyzed and rejected based on same rationale as set forth for claim 1 above.

4.2. Claims 2-5, 7, 9-13, 16-19, 21, 23-26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein and further in view of Stefik.

Regarding claims 2 & 7, it is already analyzed above that Epstein teaches a display means with the intended use of displaying title of digital content and also number of possible checkouts. Epstein's invention and disclosure are directed to control and monitor the predefined usage rights of digital content [such as downloaded music or other digital data]. Epstein does not teach using predetermined symbol[s] to display the number of available usage rights, such as remaining samples to be used or possible downloads/loans to other devices. However, Stefik, in the same field of endeavor, that is monitoring and controlling of usage rights of downloaded content, teaches using symbols/codes to denote the manner of use/usage rights, such as remaining samples to be used or possible downloads/loans to other devices (see at least Abstract, col.3, line 60-col.4, line 7, col.17, line 12-col.21, line 14, claims 1, 19 and 38. See, for example, col. 18, lines 30-41, "Grammar element 1505 "Transport-

Code:=[Copy.vertline.Transfer.vertline.Loan [Remaining-Rights: Next-Set-of-Rights]] [(Next-Copy-Rights: Next-Set of Rights)]" . Here, the Transport symbol/code is indicative of useable rights allowing the making of persistent, usable copies of the digital work on other repositories, determining the rights on the work after it is transported. If this is not specified, then the rights on the transported copy are the same as on the original. The optional Remaining-Rights specify the rights that remain with a digital work when it is loaned out. If this is not specified, then the default is that no rights can be exercised when it is loaned out. Therefore, in view of Stefik in the same field of endeavor, that is monitoring and controlling of usage rights of downloaded content, it would be obvious to one of an ordinary skilled in the art to use predetermined symbols in Epstein to denote the manner in which the useable rights can be used because using the grammar of symbols for denoting usage rights makes it convenient to define various forms of usage rights (see Stefik, col.17, lines 12-22).

Regarding claim 3, Epstein teaches that the apparatus according to claim 2, further comprising:

a display controlling means for changing, when the content checkout setting means has set the content which is to be checked out, the existing number of possible checkouts to a one for the content set by the content checkout setting means and displaying the new number and a checkout means for checking out the content set by the content checkout setting means to an external device connected to the apparatus (see at least Figs.1 and 2, col.3, lines 1-25 and col.4, lines 51-64. The catalog

controller 110 of the Check-out / Check-in Device contains a list of each checked out and checked in content and tracks the number of copies checked-out to external devices or checked in from external devices. The Checkout and Check-in Device contains the means for displaying a number of possible checkouts for the content. When a copy of content is returned, that is checked back into the Device, the count of possible available checkouts is accordingly changed that is the Device indicates that one additional copy is now available for checkout.)

Regarding claim 4, Epstein teaches that the apparatus according to claim 2, further comprising:

a checkout or check-in means for checking out or in the content set by the content checkout setting means to the connected external device to or from the connected external device and a display controlling means for changing, when the checkout or check-in means has checked out the content, the existing number of possible checkouts corresponding to the content checked out by the checkout or check-in means and displaying the new number of possible checkouts (see at least Figs.1 and 2, col.3, lines 1-25 and col.4, lines 51-64. The catalog controller 110 of the Check-out / Check-in Device contains a list of each checked out and checked in content and tracks the number of copies checked-out to external devices or checked in from external devices. The Checkout and Check-in Device contains the means for displaying a number of possible checkouts for the content. When a copy of content is returned, that is checked back into the Device, the count of possible available checkouts is

accordingly changed that is the Device indicates that one additional copy is now available for checkout.).

Regarding claim 5 , Epstein teaches that the apparatus according to claim 4, wherein the display controlling means changes the existing number of possible checkouts to a one for the content checked in by the checkout or check-in means (see at least Figs.1 and 2, col.3, lines 1-25 and col.4, lines 51-64. When a copy of content is returned, that is checked back into the Device, the count of possible available checkouts is accordingly changed that is the Device indicates that one additional copy is now available for checkout.)..

Regarding claims 9-13, 16-19 and 21, 22-26 and 27, their limitations are similar to the limitations of claims 2-5 and 7 and are therefore analyzed and rejected based on the same rationales as set forth for claims 2-5 and 7 above.

4.3. Claims 6, 14, 20 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein and further in view of Acres (US Patent 6,319,125 B1)

Regarding claim 6, 14, 20, Epstein teaches an information processor, a method for processing information and a computer program for processing checkouts and check ins of digital content to or from external device controlled by predetermined usage rights, as analyzed above for claims 1, 8, 15 and 22. Epstein does not disclose that in

the number of checkouts displaying step, a number of possible checkouts is displayed by a predetermined kind of musical-note. The examiner would like to make a note that using a sound alert with a particular musical note is a very well known phenomenon to alert an user about a particular computer event, such as imputing wrong entry, end of a session or alerting about an incoming e-mail, etc. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art of Acres is reasonably pertinent to the particular problem of using a sound alert to indicate to the user that the displayed decremented bonus has been decremented to less than one credit and that he is required to earn more welcome back bonus points (see Acres, col.11, lines 44-57) which is similar to the problem with which the applicant was faced in using a predetermined kind of musical note denoting the number of remaining checkouts left, such as Zero or one checkout. In view of Acres, it would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have included the feature of using a predetermined sound alert, that is a musical note to denote the end of possible samples/downloads or one possible sample/download I Epstein so as to prepare the user for future action.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Matsushima et al. (US 2002/0165825 claiming priority to Application number: 09/585,424, filed on June 2, 2000), see at least Abstract, paragraphs 0041, 0063, 0068, 0139, discloses the process of checking-in and checking out digital content.

Okamoto et al. (US 2005/0160053 A1 claiming priority to Application number: 09/506.098, filed on Feb 17, 2000), see at least Abstract, paragraphs 0021, 0144, 0158, 0164, discloses the process of checking-in and checking out digital content.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
7/30/2007